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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,969	02/17/2001	John F. Meyer	10004141-1	1762

7590 12/12/2005

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EXAMINER

LANEAU, RONALD

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/785,969

Applicant(s)

MEYER ET AL.

Examiner

Ronald Laneau

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. In view of the Pre-Brief Appeal Decision, prosecution of this case is hereby reopened. Claims 1-5 and 7-37 remain pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7-10, 13-16, 18, 24-28, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Bidun (WO 200163518 A2) and further in view of Miyamoto (US 6,456,391 B1).

Parulski teaches a method of receiving a least one digital image from memory of an imaging device (col. 13, lines 43-45), performing a point-of sale transaction for storing a least one digital image at a remote site (see abs., lines 8-10; the uploading is done to a remote site from the electronic database). Uploading can be done via the Internet and the remote storage site would include an image storage web site (col. 8, line 67 to col. 9, line 4, fig. 2). Parulski further teaches that removing memory accesses the digital image from the imaging device and inserting the memory into a memory reader (Fig. 29 (0012)).

Bidun teaches that at least one digital image is received by reading memory that has been removed from the imaging device (pg. 24, lines 9-14 and pg. 25, lines 1-8). There are two well-

Art Unit: 3627

known mechanisms by which a digital image can be stored in a digital cameral, internal memory and removable memory. Internal memory is limited in the amount of data, which can be stored without deleting any images. Removable memory is still limited in the amount of images, which can be stored. However, the memory can be removed and additional memory can be purchased. Even with this benefit, the cost of this memory is much more expensive than the cost of average film or downloading of the images. Additionally, Bidun teaches that convention digital capture devices typically include a limited internal memory unit for storage of digital photos or videos and that the compact nature of the device also generally limits the space allocated for internal memory so that once the stored data fills allocated space the digital information must be uploaded and erased or the entire memory unit must be replaced in order to store additional data. Pg. 1, lines 7-11. Moreover, Bidun teaches that removing a filled memory unit from the device for later processing is inconvenient and can result in the loss of the memory unit and stored data Pg. 2, lines 1-4 and further teaches that obtaining additional memory units to replace filled memory units requires the user to purchase and transport multiple memory units, which may be cumbersome and expensive. Id. As far as storing the at least one digital image at the remote site, this is common to one of ordinary skill in the art to have a digital image stored at a remote location using a computer to download the image and save it at a remote location as claimed.

Neither Parulski nor Bidun teaches printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). The index print in this case would be equaled to the sale receipt Applicant claims because it is the confirmation of all images stored.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the well-known step of receiving and accessing at least one digital image by reading memory that had been removed from the digital imaging device as already taught in Bidun for the purpose of being able to have the ability to access all types of digital cameras and thus be able to service all customers at the kiosk thereby maximizing revenues and profits.

It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view to confirm storage of the digital image or documents as taught by Miyamoto into the combined teachings of Parulski and Bidun because it would maximize the efficiency of storing and indexing electronic documents.

Claims 19-21 are rejected for the same reasons set forth in the method claim above.

As per claims 8 and 9, Bidun teaches that the remote site is a server/image storage web site (pg. 11, lines 3-5, pg. 20, lines 21-23). Bidun teaches that storing digital images takes up space and that the uploading of the stored information directly to a personal computer required the availability of such a computer when using the capture device can be cumbersome or inconvenient. Additionally, Bidun teaches that convention digital capture devices typically include a limited internal memory unit for storage of digital photos or videos and that the compact nature of the device also generally limits the space allocated for internal memory so that once the stored data fills allocated space the digital information must be uploaded and erased or the entire memory unit must be replaced in order to store additional data. Pg. 1, lines 7-11. Moreover, Bidun teaches that removing a filled memory unit from the device for later processing is inconvenient and can result in the loss of the memory unit and stored data. Pg. 2, lines 1-4. He further teaches that obtaining additional memory units to replace filled memory units requires the

Art Unit: 3627

user to purchase and transport multiple memory units, which may be cumbersome and expensive. Id. Thus, Bidun teaches that several of the objects of his invention are fulfilled by a multi-functional kiosk apparatus that permit gathering and/or transmitting data to a desired remote location. Pg. 2-3, lines 14-5.

Image storage web sites are connected to a remote server were well-known in the art for just these purposes, i.e. Shutteriy.com, Fujifilm.net, clubphoto.com, photoaccess.com and Applicant's own site cartoga.com, among many others.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have utilized a remote site of an image storage web site, which would have incorporated a server as already taught in Bidun because the skilled artisan would have recognized that this business practice accrues the advantages explicitly taught by Bidun.

As per claims 30-32, the combined systems of Bidun, Parulski and Miyamoto does not expressly teach a method wherein uploading the at least one digital image to the remote site further comprises mailing the recordable medium to the remote site, wherein the recordable medium is a CD-ROM and wherein the recordable medium is a tape but it is obvious that having a CD ROM and a tape as a recording medium is well known in the art and one would be able to mail it to a remote site after storing it in a CD ROM or a tape as claimed.

Parulski does not teach printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). The index print in this case would be equaled to the sale receipt Applicant claims because it is the confirmation of all images stored. It would have been

Art Unit: 3627

obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view for the same reasons given above.

As per claims 15 and 16, the following means are equivalent to the descriptions set forth in the reference.

Means for receiving digital images from imaging device memory (equivalent to a digital camera where the image data is received by reading by reading memory that has been removed from the camera);

Means for performing point-of-sale transactions for storing at least some of the images at a remote site (equivalent to the uploading done to a remote site the image server as it is not stored in your camera or PC it is remote).

Means for electronically transmitting paid-for images to the remote web site (equivalent to the uploading is done to a remote site from the electronic database; See abs., transfer includes docking station, modem, transceiver, cable telephone line – all electronic forms).

Parulski teaches an article for a machine having a processor (CPU for the server) and an interface (the software on the website that enables a program to work with the user/input device (the user interface, which can be, a command-line interface, menu-driven, or a graphical user interface), with another program such as the operating system or the computer's hardware), the article comprising:

Computer memory (server); and

A program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the

Art Unit: 3627

remote site (how the web site operates as set forth in the method, it could not operate without a computer program encoded into the computer memory). Thus, the article for manufacture is rejected for the reasons set forth in the method claims and the explanation set forth above.

Parulski teaches a digital image display device 500 that produces color LCD, from image provided on a removable memory card 530 or via a host interface 542 fro a host computer 540 (col. 13, lines 46-50).

Neither Parulski nor Bidun teaches printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view for the same reasons given above.

4. Claims 4, 5, 17, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Bidun (WO 200163518 A2) and further in view of [www.telepix.com](http://www.telepix.com)

Neither Parulski nor Bidun teach printing a sales receipt for the transaction identifying information about the digital images that were paid for. [www.telepix.com](http://www.telepix.com) teaches receiving at least one digital image from memory of an imaging device, storing at least one digital image at a remote site (image storage web site) and allowing it to be accessed, uploading digital images to the remote site via the internet from a wide variety of digital camera memory cards, printing a sales receipt for transactions that occur at the kiosk (Photostation 2000 - automatic job order



Art Unit: 3627

logging and receipt printing). [www.telepix.com](http://www.telepix.com) further teaches that the kiosk is a mini-kiosk (has a memory card reader - external compact flash, smart media, PCMCG card reader), a processor responsive to the card reader and programmed to perform a point-of sale transaction and sends digital images to a remote storage site (400 MHz AMD K.6 processor - automatic job order logging and receipt printing; internet connectivity to Telepix Photo Network - display, share, download, email and print), a data communication device responsive to the processor for sending the digital images to the remote site (Integrated 10/100 Ethernet network port, Dual Universal Serial Bus, Supports dial-up, ISDN, ADSL or cable modem connectivity), at least one device, coupled to the processor, for entering payment information (wireless infrared keyboard for enhanced security in setup and administration, easy to use touch screen user interface), a receipt printer coupled to the processor, whereby the processor can command the printer to print out receipts of the transactions (receipt printing).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of providing a printed sales receipt through a printer in the mini-kiosk as taught in [www.telepix.com](http://www.telepix.com) in the combined system of Parulski and Bidun as this business practice provides the customer with necessary information, saves time spent by a customer in making purchases, enhances customer satisfaction and entices customers to stay with the business. Moreover, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added identifying information about the digital images that were paid for to the receipt for the reasons set forth above.

Art Unit: 3627

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Bidun (WO 200163518 A2) as applied to claims 1 and 11 above, and further in view of Eastman Kodak: Kodak to acquire 51% state in Picture Vision, M2 Presswire, February 13, 1998, pg. 1.

Parulski and Bidun teach as set forth above. However, neither Parulski nor Bidun teach that the owner of the kiosk has a fee agreement with the owner of the storage site. M2 Presswire teaches that PictureVision built the leading franchise at retail, i.e. digital image storing. Franchising is a form of a fee agreement with an owner of a remote storage site. M2 Presswire further teaches that this form of transaction based processing gives customers more benefits by allowing them to share their photos quickly and easily through the combined service, i.e. retail kiosks and the owned remote storage. Moreover, it is well known in the business art that if one does not own space one pays for it, i.e. rents it, leases it, or buys it. The same is true of a service that one provides to a customer. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of having the owner of the kiosk have a fee agreement with the owner of the remote storage site in the combined system of Parulski and Bidun as taught in M2 Presswire because the skilled artisan would have recognized that this business practice is a mechanism by which the remote storage site stays profitable and stays in business, would follow in the internet world from the business community where competition is sometimes world wide and customers have a greater influence on the success of a business and provides a valuable service to the kiosk owner by avoiding the need for him incur the costs of setting up his own web site for his customers, when he can pay a low fee for a site that is already set up and can be off-set in other negotiated ways through the franchised licensing agreement.

***Response to Arguments***

6. Applicant's arguments filed on 10/18/05 have been fully considered but they are not persuasive.

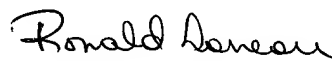
Applicant's arguments about Altman are moot in view of the newly added reference in Miyamoto who discloses a printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed. Applicant further argues that none of the references teaches or suggests "sending digital images from a user's digital camera to a remote storage site." In response to Applicant's arguments, this common in the business art to use a digital camera to send digital images to a remote storage. A charge will be determined for storing these digital images depending of the length of time these images are being stored in the remote storage facility. Applicant argues that the examiner fails to make a prima facie case of obviousness since there is no suggestion or motivation to modify the references or combine reference teachings so as to arrive at the claimed invention. In response to applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Art Unit: 3627

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ronald Laneau  
Examiner  
Art Unit 3627

11/30/05

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